## REMARKS

Claims 22 to 46 and 49 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 22 to 24, 26 to 28, 31 to 34, 36, and 39 to 45 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado et al. U.S. Patent No. 7,051,005 (Peindado) in view of Serkowski U.S Patent No. 6,513,121 (Serkowski).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there may be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination may be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 22, as presented, relates to a data transmission method, and includes the features of transmitting first data to a first processor, transmitting second data to a second processor, the second data being based on the first data, checking the second data in the second processor to determine if the first data may be processed in the first processor, transmitting a check result to the first processor, the check result being a positive or a negative check result, responsive to receiving a positive check result, processing the first data at the first processor. The Final Office Action admits that Peinado does not disclose the

feature of transmitting a check result to the first processor when the result is negative (*see* Final Office Action, page 4, lines 9 to 11), but relies on Serkowski as assertedly disclosing the feature.

As to claim 22, there is no teaching or suggestion so as to combine or modify the Peinado and Serkowski references. In the Response to Arguments section, the Office conclusorily asserts that the motivation to modify is that one skilled in the art "recognize[s] the teaching of sending a negative result allows the system and user to be aware of the failure and use that information" (*see* Final Office Action, page 8). However, Peinado itself makes it plain that the asserted modification is improper.

The Peinado reference concerns a digital right management (DRM) system that includes a content server, a license server, and a user computer equipped with a black box for encryption and decryption of public and private keys. The Peinado reference makes it plain that the black box is mere executable code that runs on user's computer. The Final Office Action is wholly unclear as to which of the Peinado components corresponds to the second processor as provided for in the context of claim 22. To the extent that the Office asserts that the user's computer corresponds to the first processor, the black box does not disclose the feature of a second processor as provided for in the context of claim 22. This is because the black box only includes computer executable codes – and not a hardware processor. The Serkowski reference does not cure this critical deficiency since Serkowski makes it plain that it merely concerns with a single processor system.

Furthermore, to the extent that the Office asserts that the license server corresponds to the second processor as provided for in the context of claim 22, there is no motivation to modify Peinado with Serkowski. Peinado in relevant parts plainly states that the "license server only issues a license to a DRM system that is `trusted` (i.e., that can authenticate itself)". (Col. 3, lines 10-12). The Peinado reference further states that:

> Once the license server 24 has received the license 16 request information 36 from the DRM system 32, the license server 24 may then perform several checks for trust/authentication and for other purposes. In one embodiment of the present invention, such license server 24 checks the certificate with the digital signature of the certifying authority to determine whether such has been adulterated or otherwise modified (steps 705, 707). If so, the license server 24 refuses to grant any license 16 based on the request information 36. The license server 24 may also maintain a list of known `bad` users and/or user's computing devices 14, and may refuse to grant any license 16 based on a request from any

> such bad user and/or bad user's computing device 14 on the list. Such `bad` list may be compiled in any appropriate manner without departing from the spirit and scope of the present invention. **19:12-27**

Accordingly, Peinado makes it plain that its system (or its license server 24) only issues a license to a "trusted" party and refuse to issue anything to any other parties. This is further evidenced by the fact that Peinado even contemplates a "bad" list based on which the license server 24 would refuse a license.

The user of the Peinado system can be anyone including those who download encrypted contents through Internet without authorization (i.e., "bad" users). Transmitting a negative check result to the user under Peinado's scenario simply does help since the user is not within the control of either the license server or content server. Therefore, the Peinado system is designed only to issue license to a trust party and to refuse to send anything to any other parties.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art system being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. 2143.01, *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As here, the asserted modification of Peinado by Serkowski would change the intended principle of operation of Peinado. Accordingly, the present application is not rendered unpatentable under 35 U.S.C. § 103(a) by the combination of the Peinado and Serkowski references.

Accordingly, claim 22 is allowable.

Claims 24, 34, and 41 to 44, as presented, include features similar to those of claim 22, and are therefore allowable for essentially the same reasons as claim 22.

Claims 23, 25 to 33, 35 to 40, and 45 to 48, as presented, depend from claims 22, 24, 34, or 41 to 44, and are therefore allowable for the same reasons.

It is therefore respectfully requested that the obviousness rejections of claims 22 to 24, 26 to 28, 31 to 34, 36, and 39 to 45 be withdrawn.

Claim 25 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of Okada, U.S. Patent No. 6,704,872 (Okada).

It is respectfully submitted that even if it were proper to modify the combination of Peinado and Serkowski, as asserted by the Office Action (which is not conceded), Okada does not cure the critical deficiencies of the combination of Peinado and

Serkowski (as explained above) with respect to claim 22 as presented, from which claim 25 depends. Accordingly, claim 25 is allowable for at least the same reasons as claim 22, as presented, since Okada does not cure the critical deficiencies of the Peinado and Serkowski references.

Claims 29 and 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski.

Since claims 29 and 30 depend on claim 22, claims 29 and 30 are allowable for at least the same reasons as claim 22, as presented.

Claim 35 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of Gurr, U.S. Patent No. 4,264,960 (Gurr).

It is respectfully submitted that Gurr does not cure the critical deficiencies of the combination of Peinado and Serkowski (as explained above) with respect to claim 22 as presented, from which claim 35 depends. Accordingly, claim 35 is allowable for at least the same reasons as claim 22, as presented.

Claims 37 and 46 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of Coley, U.S. Patent No. 5,790,664 (Coley).

It is respectfully submitted that the Coley reference does not cure the critical deficiencies of the Peinado reference (as explained above) with respect to claim 22 as presented, from which claims 37 and 46 depend. Accordingly, claims 37 and 46 are allowable for at least the same reasons as claim 22, as presented.

Claim 38 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of Flick, U.S. Patent No. 6,140,939 (Flick).

It is respectfully submitted that the Flick reference does not cure the critical deficiencies of the combination of Peinado and Serkowski (as explained above) with respect to claim 22 as presented, from which claim 38 depends. Accordingly, claim 38 is allowable for at least the same reasons as claim 22, as presented.

Claim 49 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of U.S. Patent No. 7,237,112 (Ishiguro).

The Final Office Action specifically admits that neither Peinado nor Serkowski explicitly discloses the feature of "deleting the first data in response to a negative check result" as provided for in the context of claim 49. However, it relies on Ishiguro as

assertedly disclosing this feature.

*However, the Ishiguro reference was originally filed in Japanese, and was only filed in English on November 24, 2000. Accordingly, it is not entitled to the PCT filing date of March 30, 2000 as prior art. The priority date of the present application is September 1, 2000 (German patent application DE 100043499.1-31). A CERTIFIED English translation of priority German application DE 100043499.1-31 was filed in the present application on December 5, 2001 (with the Response to Notice to File Missing Parts), and another copy accompanies this response. Therefore, Ishiguro on its face is not a prior art reference as to the present application.*

*It is also noted that the PCT publication date of Ishiguro is October 5, 2000 which is also after the priority date of September 1, 2000 of the present application.*

*It is therefore respectfully requested that Ishiguro be withdrawn as prior art.*

As further regards Ishiguro, it is respectfully submitted that Ishiguro does not cure the critical deficiencies of the combination of Peinado and Serkowski (as explained above) with respect to claim 22 as presented, from which claim 49 depends. Accordingly, claim 49 is allowable for at least the same reasons as claim 22, as presented.

Withdrawal of these obviousness rejections is therefore respectfully requested.

Accordingly, claims 22 to 46 and 49 are allowable.

**Conclusion**

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Office have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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